

Remarks/Arguments

Claims 1-16 are pending in the application. The specification is amended to address the objections raised by the Examiner. Claims 1-16 are rejected as obvious under 35 USC § 103 using Angwin et al. as the primary reference. Claims 1-3, 5, 7-8, 11, 13, and 15-16 have been amended. Support for the amendments is found throughout the specification, for example, see page 3, 2nd paragraph and page 12, bottom paragraph.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Angwin et al. is directed to a method for allowing a pervasive computing device to retrieve a services menu. The problem addressed by Angwin et al. is connecting the devices to a network source with the service menu even though there may not be prior knowledge of the network environment by the device. (See Col. 2, lines 27-38, for example.) Angwin et al. does not detail the delivery of any kind of content information to the devices other than a service menu, and certainly does not discuss how to configure devices and/or a network for delivery of content information under a URL or identifier associated with an apparatus and in the context of usage of the apparatus. In making

the rejections, the Examiner cites Col. 2, lines 15-21 as teaching a consumer apparatus responsive to a user-input for initiating retrieval of data from a server under the control of a predetermined URL specific to a type of the apparatus. However, the cited passage is not describing the inventive system in Angwin et al. Rather, Angwin et al. is contrasting prior devices with its reportedly inventive device, basically stating that prior devices are unsuitable because they are configured to access a URL for a services menu, which requires network knowledge. Angwin et al. teaches against using a URL and instead uses a "Request Services Menu message" to solicit from the network a services menu. Angwin et al. teaches that this overcomes the disadvantages purported to be associated with accessing network resources through a URL associated with a device:

by broadcasting a request for services menu to network, the pervasive computing device does not need to know in advance the location of the server which provides the service menu to the device. (Col. 2, lines 62-65.)

Fundamentally, Angwin et al. is teaching against the particular feature of the claimed invention calling for a predetermined URL to be associated with the apparatus claimed. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). It would modify the principle of operation of Angwin et al. to provide such a URL retrieval based service.

Therefore the other limitations in the claims that the Examiner cites as being disclosed in Angwin et al., cannot be combined with the feature of a predetermined URL to arrive at the claimed invention. Accordingly, the Examiner's rejection of all claims is therefore traversed because all are based on Angwin et al.

To help the Examiner better appreciate the distinctions between the present invention and Angwin et al., the independent claims have been amended to recite one or more of the following: (1) an apparatus for a home network; (2) an associated URL or identifier therefor is stored on the home network; and/or (3) a URL or identifier for accessing data associated with a server that is remote from the home network. Clearly, these features, as recited in the amended claims, are not found in any cited reference, alone or in combination.

As another basis for traversing the rejections, all the independent claims recite that the data represents content information about a context of usage of the apparatus, the Examiner considers that it would be obvious to have one of the services sent to the device represent content information about the context of usage, but does not identify any teaching or suggestion in the cited references for this point. To the extent any service menu listing might be considered a URL, or an identifier therefor, for a service that might be deemed data representing content information about the context of usage of the apparatus, it is important that the Examiner recognize that the relevant claims recite that the URL or identifier for contextual information about usage of the apparatus is stored on a home network including the apparatus and is not retrieved from a remote server, as taught in Angwin, et al.

As another point of distinction, nothing in Angwin et al. teaches that a device accesses a predetermined URL contextual information for a consumer apparatus through a predetermined URL based on **user input**, as opposed to automatic, preconfiguration for accessing network resources. In fact, Angwin teaches that the services menu is delivered automatically without user input: "when one of the data processing systems ... initially establishes a connection to a network, the system broadcasts a Request Services Menu message on the network." (Col. 7, lines 8-12.). Accordingly, nothing in Angwin et al. teaches or suggests that a user input activates retrieval of the contextual data under a particular URL.

The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In view of the foregoing paragraphs, the Examiner's explicit and implicit conclusions about the desirability of the modification of Angwin et al. are the Examiner's alone, and no teaching or suggestion for the desirability has been identified in the cited art. The particular problem addressed in Angwin et al. is providing a system for accessing a services menu when prior knowledge of the network is unavailable. The content information about a context of usage recited in the claims would play no role in the network configuration and methods used in solving the Angwin et al. problem. Therefore there would be no desirability for such. The rejections are therefore traversed and the rejections must be withdrawn unless evidentiary support is provided, as noted below.

The MPEP 2144.03 dictates against using common knowledge in the art, as has been combined with Angwin et al. to reject claims:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore. . . any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

The examiner's reliance on common knowledge or official notice is therefore improper and has been traversed. Applicant submits that at the time of invention, there was not common knowledge for the combination, and requests that the Examiner provide evidentiary support as required under MPEP 2144.03.

C.

Turning now to the rejection of claims 4, and 9-12 based on Angwin et al. in view of Beranek et al., the rejections must be withdrawn in view of the deficiencies in Angwin et al. and/or in view of the amendments. Here the conclusions about the desirability of the modification of Angwin et al. are the Examiner's alone, and no teaching or suggestion for the desirability has been identified in the cited art. The particular problem addressed in Angwin et al. is providing a system for accessing a services menu when prior knowledge of the network is unavailable. The remote control and related features recited in claims 4 and 9-12 would play no role in the network configuration and methods used in solving the problem. Therefore there would be no desirability for such. The rejection is therefore traversed and the rejections must be withdrawn unless evidentiary support is provided.

Turning now to the rejection of claim 8 based on Angwin in view of Duberman et al., the rejections must be withdrawn in view of the deficiencies in Angwin et al. and/or in view of the amendments. Also, the Duberman reference is a mere newsletter reporting on technical developments and does not contain sufficient technical details itself to constitute an enabling disclosure. Further, the mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here the conclusions about the desirability of the modification of Angwin et al. are the Examiner's alone, and no teaching or suggestion for the desirability has been identified in the cited art. The particular problem addressed in Angwin et al. is providing a system for accessing a services menu when prior knowledge of the network is unavailable. The proxy recited in claim 8 would play no role in the network configuration and methods used in solving the problem. Therefore there would be no desirability for such. The rejection is therefore traversed and the rejections must be withdrawn unless evidentiary support is provided.

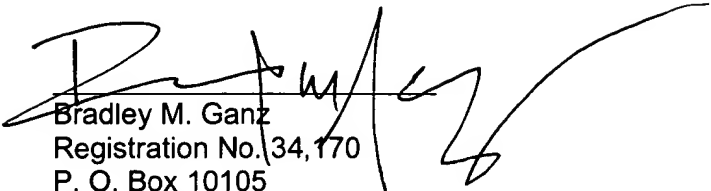
CONCLUSION

Applicant submits that in view of the foregoing arguments and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested. The Commissioner is hereby authorized to charge any fees, including

extension fees, which may be required, or credit any overpayments, to Deposit Account
No. 50-1001.

Respectfully submitted,

Date: July 25, 2003



Bradley M. Ganz
Registration No. 34,170
P. O. Box 10105
Portland, Oregon 97296
Telephone: (503) 224-2713
Facsimile: (503) 296-2172
email: brad@ganzlaw.com

Correspondence to:

Philips Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131 USA
Telephone: (408) 617-7700
Facsimile: (408) 617-4856
USPTO Customer Number: 24738